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No. 03-615

IN THE

Supreme Court of the United States

TODD MCFARLANE, *et al.*
Petitioners,

v.

ANTHONY R. "TONY" TWIST,
Respondent.

On Petition for a Writ of Certiorari
To The Supreme Court of Missouri

REPLY BRIEF FOR THE PETITIONERS

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REPLY BRIEF FOR THE PETITIONERS

I. Respondent Distorts First Amendment Principles And This Court's Precedents In His Attempt To Defend The Decision Below.

This Court has consistently fashioned comprehensible doctrines to insure a measure of certainty and predictability for all parties when it formulates standards to accommodate interests pressing on First Amendment freedoms. For example, when this Court recognized the important First Amendment concerns implicated by the common law of defamation, it did not respond with a vague invitation to engage in unrestrained balancing of competing interests. Instead, *New York Times v. Sullivan*, 376 U.S. 254 (1964), and its progeny fashioned a set of rules that confines such varying judgments and thereby enables publishers and litigants to limit the range of their uncertainty.

Here, however, the Missouri court rejected the two prevailing standards for reconciling the tension between the right of publicity and First Amendment principles and instead announced an inherently vague and unpredictable balancing approach that leaves the First Amendment—and the authors and publishers who rely upon its protection—subject to the individual artistic tastes of judges and juries. As the *Amici* cogently explain in their brief, the "predominant use" test jeopardizes artistic freedom throughout the country.

In response, Respondent parades *Zacchini* throughout his brief as if that case had any meaningful relevance here. In fact, the property at issue in *Zacchini* was plaintiff's livelihood—a human cannonball act—broadcast by the defendant in its entirety, without the plaintiff's consent. The broadcaster's action was more akin to a copyright violation in which the copier pub-

lished the owner's work in its entirety. Here, Petitioners used only Respondent's name, and only in a fictionalized setting that, as the court below confirmed, did not defame him. As the *Amici* illustrate with a wealth of examples, such fictionalized use of well-known persons' names has been a common practice for as long as there has been fiction.[1]

Respondent urges on this Court the same misconstruction of the expressive-commercial balance that misled the court below. As for the expressive part of the balance, Respondent fails to grasp that a work and its elements are "expressive" regardless of whether the work is deemed to be high art. Any writing designed to delight, amuse, titillate, distract, instruct, or inspire is expressive—whether written for groundlings or box seats, whether as a comic book or a grand opera. If a name chosen by the author has a certain "music" and a certain resonance with ideas, names, and persons with

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[1] Respondent's invocations of *San Francisco Arts and Athletics, Inc. v. United States Olympic Committee*, 483 U.S. 522 (1987), and *Lloyd Corp. v. Tanner*, 407 U.S. 551 (1972), are even more unavailing. The *Olympic Committee* case involved the misappropriation of the Committee's *trademarked* name for its product as the product name for an unlicensed, unaffiliated entity's own product. Neither product was an expressive work. More to the point would be a film or a story about the defendant's athletic contest, which used in the text of the story the phrase "gay Olympics." Surely there could have been no injunction against such terminology in an expressive work. Indeed it is doubtful that the United States Olympic Committee could have complained if a book about the defendant's event had been titled "San Francisco's Gay 'Olympics.'" The reference to *Lloyd v. Tanner* is even more farfetched. In that case, the Court said that speakers had no more right to speak and leaflet on private property than they did in a person's living room. To be sure, both cases present conflicts between property rights and First Amendment liberties, but to take the conflict at such a high level of abstraction sheds no light on this specific issue—or any other.

which the audience may be familiar, that is enough to make that use expressive. One need only look to *Amici*'s example of Yogi Bear to grasp that point.

As for the "commercial" side of the balance, this Court's precedents reject a rule of law that would make an expressive work "commercial" if one or more of its elements have been chosen to help it sell. *E.g., Harte-Hanks Communications, Inc. v. Connaughton*, 491 U.S. 657, 667 (1989). As Dr. Samuel Johnson famously remarked, "No man but a blockhead ever wrote, except for money." James Boswell, LIFE OF JOHNSON 641 (Everyman's Library 1993). So long as the expressive use of a public figure's name carries no implication of endorsement, the fact that its use in a work of fiction may make the work sell better does not convert that work into a commercial one.

Respondent creates additional confusion through his failure to distinguish between (a) the use of a public figure's name in an expressive work that may sell more issues because of the resonance that the use gives to that work, and (b) the use of a public figure's name to advertise a product, *e.g.*, a celebrity endorsement. Is the fictional mobster Tony Twist to be understood as depicting the real life of Respondent? Of course not, and neither Respondent nor the court below contends otherwise. But is there nevertheless a correlation between the fictional character and Respondent? As the court below stated, the "unmistakable correlation between Twist the hockey player and Twist the Mafia don that, when coupled with Twist's fame as a NHL star, conclusively establishes that [Petitioners] used his name and identity." (Pet. App 10-11.) But precisely the same might be said about the cartoon character Yogi Bear and the baseball celebrity Yogi Berra, or any of the myriad other examples offered by *Amici*. The mere fact

of that correlation—even when it is "unmistakable"—does not transform a protected work of expression into an unprotected advertisement.

II. Respondent Attempts To Deny What Even the Court Below Readily Admitted, Namely, That Its Decision Creates A Deep Conflict Among the Nation's Courts.

Respondent tries to explain away the conflict among the lower courts by contending that the two extant rules—namely, the "relatedness" test enunciated by the Restatement (Third) of Unfair Competition (and most recently adopted by the Sixth Circuit in *Parks v. LaFace Records*, 329 F.3d 437 (6th Cir.), *petition for cert. filed*, 72 U.S.L.W. 3269 (U.S. Sept. 30, 2003) (No. 03-504)), and the "transformative" test adopted by the California Supreme Court (most recently in *Winter v. DC Comics*, 69 P.3d 473, 477-78 (Cal. 2003))—are but two particular iterations of the Missouri court's more general balancing approach. (Brief in Opp. at 12-13.) We understand that it is a staple of Briefs in Opposition to deny the existence of any conflicts, just as it is of Petitions for Certiorari to claim them. If there would be any doubt as to the existence of the conflict, we suggest that the Supreme Court of Missouri should be heard on the issue:

> The weakness of the Restatement's "relatedness" test and California's "transformative" test is that they give too little consideration to the fact that many uses of a person's name and identity have both expressive and commercial components.... Though these tests purport to balance the prospective interests involved, there is no balancing at all—once the use is determined to be expressive, it is protected.

(Pet. App. A-18)

Indeed, the very court decisions Respondent seeks to harmonize expose the hollowness of his argument. Even the Missouri Supreme Court acknowledged that the *Winter* case was "a case with a remarkably similar fact situation." (Pet. App. at A-17.) Yet application of the "transformative" test produced a result opposite to that reached by the Missouri court. *Winter v. DC Comics*, 69 P.3d. at 477-78. As for the "relatedness" test—first adopted by the Second Circuit and most recently adopted by the Sixth Circuit—the Missouri court rejected it because under that test "use of a person's name and identity is actionable only when the use is solely commercial and is otherwise unrelated to that person." (Pet. App. at A-18.)[2]

III. This Case Is Ripe For Review Under The *Cox Broadcasting* Test.

Petitioners' federal defense throughout these proceedings has been that their use of the name "Tony Twist" is protected expression under the First Amendment. The court below applied its anomalous new balancing test to the trial record and rejected that defense, holding that "free speech must give way to the right of publicity." (Pet. App. A-19.) Respondent's attempt to argue around the finality rule in *Cox Broadcasting Corp. v. Cohn*, 420 U.S. 469 (1975), appears to be premised on a misunderstanding of the "intent" issue on which the court below relied in granting a new trial. As the Missouri court held:

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[2] Respondent makes the irrelevant point that Petitioners do not here embrace one or the other of the extant conflicting standards. Brief in Opp. at 14. That choice, however, is a question for the briefing on the merits and ultimately for this Court. At this stage it is sufficient to demonstrate the manifest conflict between those extant standards and the one proposed by the court below.

> Because the verdict director allowed the jury to render a verdict for plaintiff without a finding that [Petitioners] *intended* to obtain a commercial advantage, and because the jury may well have determined that [Petitioners] obtained a commercial advantage even though they did not intend to do so, the verdict must be set aside.

(Pet. App. A-21.)

Accordingly, the intent at issue in that holding was *not* a constitutional "actual malice" intent of the *New York Times v. Sullivan* variety but a garden-variety common law intent under the third element of the tort, namely, use of the name "with the intent to obtain a commercial advantage." (Pet. App. at A-20.) Indeed, the opinion below does not even address the intent element until *after* applying its "predominant use" test and concluding that "free speech must give way to the right of publicity."

Quite simply, Petitioners' First Amendment defense is premised upon the principle that they have a right to use the name "Tony Twist" in a non-defamatory, expressive manner even if they obtain a "commercial advantage" from that use *and* even if they *intended* to obtain it. The Missouri court has rejected that defense under a new First Amendment test that conflicts with the established ones. There is thus no reason to force Petitioners to endure the time and expense of another multi-week trial—plus the crippling prospect of another $24.5 million verdict—when the dispositive federal rule has already been finally and erroneously determined against them. As the Supreme Court of California ruled in the context of California law in the almost identical *Winter* case, *supra*, because "unnecessarily protracted litigation would have a chilling effect upon the exercise of First Amendment rights, speedy resolution of cases involving

free speech is desirable." 69 P.3d. at 480 (internal quotes and quoted case omitted).

CONCLUSION

The petition for certiorari should be granted.

Respectfully submitted,

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